

**REMARKS**

Claims 1-24 were in the application as filed. Claims 1-13, 18-20, and 22-24 were canceled and claims 25-28 were added in the Preliminary Amendment filed on December 4, 2003. Claims 14-17, 21, and 25-28 remain in the application.

Claim 14 has been amended in order to write this claim in the appropriate U.S. claim format.

Claims 1-4 are rejected under 35 U.S.C § 103(a) as being unpatentable over Camus et al. (Reference A).

This rejection is rendered moot and should be withdrawn in view of the cancellation of claims 1-4 in the Preliminary Amendment filed on December 4, 2003, which apparently has not yet been entered by the Examiner.

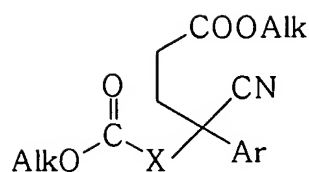
Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,242,607, issued to Camus et al. In support of this rejection, the Examiner has stated that:

Camus et al. teaches that the instant compound, of formula II a, where Alk is CH<sub>2</sub>, and Ar is 3,4-dichlorophenyl. At column 11, lines 46-47, see compound, formula IIa. The difference between the prior art compound and the instantly claimed compound is the claiming of a diester of the compound vs. a monoester of the compound. The Camus compound is a diester of the monoester Camus compound, which has a free carboxylic acid moiety in the compound. The claimed esters are structurally obvious over the free acid of the Camus compounds, see In re Schaub 190 USPQ 324.

It would have been obvious for one of ordinary skill in the art to modify one of the carboxylic acid portion of Camus compound to obtain the instant diester. Therefore, the instant compounds are prima facie obvious in the absence of unexpected results.

This rejection is traversed, and reconsideration and withdrawal thereof are respectfully requested for the reasons given hereinbelow.

The Camus disclosure is directed generically to novel glutarimide intermediates taught to be useful for the preparation of 3,3-disubstituted piperidines. Also disclosed are methods of preparing these glutarimides via novel intermediates. At column 11, Camus et al. disclose the preparation of the compound of Formula IIa:



(IIa)

in which  $X=CH_2CH_2$ ,  $Alk=CH_3$ , and  $Ar=3,4$ -dichlorophenyl.

Initially, Applicants point out the instantly rejected compounds have both an ester moiety and a carboxylic acid moiety, whereas Camus's compound described at column 11, line 34-48 is the diester compound, not the "free acid" as stated by the Examiner. Moreover, Applicants respectfully submit that the citation of *In re Schaub* is misapplied to the case at bar. In particular, the Appellants of *In re Schaub* were attempting to antedate a prior art reference disclosing their carboxylic acid compound, by showing a prior reduction to practice of both a similar ester *and* a carboxylic acid compound, and hence, that they possessed "so much of the invention as to encompass" the prior art carboxylic acid compound before its disclosure. Nowhere, however, did the Court of Customs and Patent Appeals opine that free acids in general are *prima facie* structurally obvious over the corresponding esters of those compounds. Therefore, *In re Schaub* clearly adds nothing to the instant rejection.

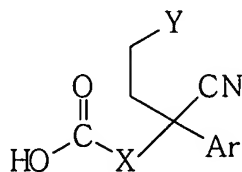
Applicants also note that the compounds of claim 17 are single enantiomers, whereas formula IIa of Camus displays a racemate, yet another difference between the prior art compounds and the instant invention. In sum, the Camus disclosure fails to provide the requisite motivation to one of skill in the art to pick and choose among the numerous substituents of formula IIa to arrive at those of the instant invention, then change only one ester moiety to a "free acid," and then to isolate the specific enantiomeric form of such compound, to finally end up at Applicants' compounds of Formula VI. Accordingly, the reference is incompetent to either teach or suggest Applicants' claimed invention, and the rejection of claim 17 based thereon should be withdrawn.

Claim 21 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Camus et al. (United States Patent No. 6,242,607). In support of this rejection, the Examiner has stated that:

Camus et al. teaches the instant compound as shown in Formula III, where Ar is phenyl substituted two times with halogen, X is ethylene, and Y is carboxy group. At column 3, line 45, see the compound of formula III and the radicals defined. The difference between the prior art compound and the instantly claimed compounds is the teaching of a generic compound versus a disclosed species. It would have been obvious to one of ordinary skill in the art to select various known radicals within a genus to prepare structurally similar compounds. For instance, see the example 1 at column 13, where a disclose species is exemplified. Accordingly, the compounds are deemed unpatentable therefrom in the absence of a showing of unexpected results for the claimed compounds over those of the generic prior art compounds.

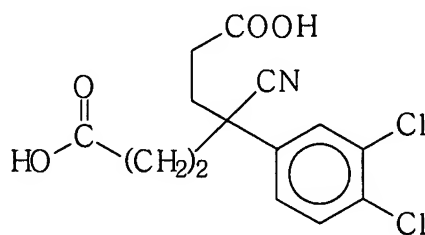
This rejection is traversed and reconsideration and withdrawal thereof are respectfully requested for the reasons given hereinbelow.

Camus discloses compound of Formula III:

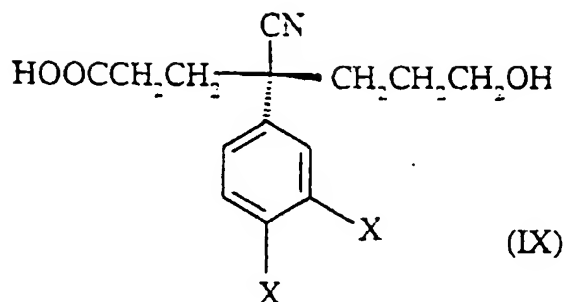


(III)

wherein Ar and X are as defined for the compounds of Formula I, and Y is a cyano or carboxy group. The compound 4-cyano-4-(3,4-dichlorophenyl)heptanedioic acid, which the Examiner maintains is a “species” of the genus of Claim 21, has the following the formula:



The instantly rejected compounds, however, have the formula:



which plainly require a hydroxy propyl substituent at the same position that the Camus intermediates require a cyanoethyl or a carboxyethyl functionality. Therefore, the Camus compound is clearly not a "species" of the compound of Claim 21. Moreover, Camus teaches that cyclisation of the intermediate products (the following step in the synthesis of the final products) is effected between two nitrile functions or between a carboxylic acid function and a nitrile (see, e.g. col. 7, lines 38-41), which functionalities the instantly rejected compounds do not contain. Accordingly, Camus provides no motivation to one skilled in the art to even prepare the compounds of Applicants' Formula IX, since the claimed compounds contain a hydroxy functionality rather than a nitrile or carboxylic acid functionality. The claimed invention would, therefore, not have been obvious to such a person at the time the invention was made and, hence, the rejection of claim 21 under 35 U.S.C. §103(a) based on said reference is believed to be unwarranted and should be withdrawn.

Claims 4, 5, 9, 10, and 17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim subject matter which Applicant regards as the invention.

With respect to claims 4, 5, 9, and 10, this rejection is moot and should be withdrawn in view of the cancellation of said claims in the Preliminary Amendment filed on December 4, 2003.

Claim 17 is rejected for the stated reason that the phrase 'R1 and X are as defined for (I) in claim 1' is indefinite, since all radicals must be defined at claim 17."

This rejection is moot in view of the Preliminary Amendment filed on December 4, 2003, in which claim 17 was amended to insert the definitions of the R1 and X substituents directly into claim 17.

The rejection of Claims 1-8 and 9-13 under 35 U.S.C. § 101 is rendered moot and should be withdrawn in view of the Preliminary Amendment filed on December 4, 2003, in which claims 1-8 and 9-13 were cancelled.

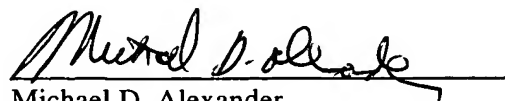
Claim 5 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claim 5 of U.S. Patent No. 6,469,173, and Claims 1-4 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 11-12 of U.S. Patent No. 6,469,173. These rejections are moot and should be withdrawn in view of the Preliminary Amendment filed on December 4, 2003, in which claims 1-5 were cancelled.

Claims 14-16 are objected to for being based on rejected claims. This objection is moot in view of the amendment to claim 14, in the Preliminary Amendment filed on December 4, 2003, wherein claim 14 was placed in independent form. Accordingly, claims 14-16 do not depend upon any rejected claims. Withdrawal of this objection is, therefore, respectfully requested.

In view of the foregoing remarks, reconsideration and withdrawal of (a) the rejection of claims 1-4 and 17 under 35 U.S.C. § 103(a), (b) the rejection of claim 21 under 35 U.S.C. § 103(a), (c) the rejection of claims 4-5, 9, 10, and 17 under 35 U.S.C. § 112, second paragraph, (d) the rejection of claims 1-8 and 9-13 under 35 U.S.C. § 101, (e) the rejection of claims 1-5 under the judicially created doctrine of obviousness-type double patenting, and (f) the objection of claims 14-16, is requested and allowance of claims 14-17, 21, and 25-28 is respectfully requested.

Respectfully submitted,

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